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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MODIANO & ASSOCIATI  
Via Meravigli, 16  
Milano, 20123  
ITALY

EXAMINER

FULLER, ERIC B

ART UNIT	PAPER NUMBER
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1762

6

DATE MAILED: 02/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/828,175

Applicant(s)

LAZZERINI, MAURIZIO

Examiner

Eric B Fuller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group 1, claims 1-12, in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: For claim 6, the specification lacks support for the limitation of "said laser beam acting on said covering layer through one of said backing layers."

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 1, the phrase "or the like" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).

As to claim 9, "type" renders the claim vague and indefinite.

As to claim 10, "preferably" renders the claim vague and indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6, and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Leenders (US 5,478,695).

Leenders teaches a support with a binder layer and a barrier layer (abstract). Preset portions of the barrier layer, which is metal, are removed by the used of a Nd-Yag laser with a wavelength of 1064 nm (column 11, lines 30-40). These removed areas provide holes that are used for imaging elements, which is a detectible code. As to claim 6, the barrier layer may be covered with another layer that is used to increase laser absorption (column 3, line 34-40).

### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 7, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harbaugh (US 5,535,871).

Harbaugh teaches a security thread for currency that is made of a plastic substrate coated with a metallic layer (abstract). Laser etching is then used to remove preset area in order to produce visible alphanumeric characters and/or machine detectible codes (column 8, line 1; column 7, lines 15-50). The reference fails to teach the wavelength or laser type used in the laser etching. However, to use a laser type and wavelength that would sufficiently etch the metallic coating without harming the plastic substrate would have been obvious at the time the invention was made to a person having ordinary skill in the art. To determine what these attributes are would have been within the skill of one in the art through routine experimentation.

The security thread is embedded into paper (column 8, line 8). To do this before or after the laser-etching step would have been obvious to those skilled in the art with the expectation of achieving similar results. The preferred metal of the coating layer is aluminum (column 7, line 60).

Claims 1, 2, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US 6,169,266 B1).

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Hughes teaches a process wherein a support layer is coated with one or multiple layers of ink (abstract; column 2, lines 61-65; column 11, line 13). Laser etching is then used to remove preset areas in order to produce alphanumeric characters and/or a bar code on the article (column 6, line 30; column 8, lines 40-45). Although the reference fails to teach which type of laser to use and at what wavelength, to use a laser type and wavelength that sufficiently etches the ink layers would have been obvious at the time the invention was made to a person having ordinary skill in the art. To determine what these attributes are would have been within the skill of one in the art through routine experimentation.

Claims 1, 3, 5, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 5,858,474).

Meyer teaches a process of laser ablation that is used to code non-magnetic areas into an article that comprises a non-magnetic substrate covered by a magnetic layer (abstract; column 7, lines 30-52). The magnetic layer is made of a cobalt alloy (column 2, line 4). Although the reference fails to teach which type of laser to use and at what wavelength, to use a laser type and wavelength that sufficiently etches the magnetic layer without causing damage to the non-magnetic substrate would have been obvious at the time the invention was made to a person having ordinary skill in the art. To determine what these attributes are would have been within the skill of one in the art through routine experimentation.

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**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moore (US 5,895,073) teaches an anti-counterfeiting system that uses marked threads. Tatah et al. (US 6,060,127) teaches laser types and wavelengths that are sufficient in etching metal. These attribute correspond to Applicant's claims. Bradley, Jr. et al. (US 5,824,374) teaches an in-situ, multi-layer coding process involving laser patterning.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
EBF  
February 6, 2002

  
SHRIVE P. BECK  
SUPERVISORY PATENT EXAMINER  
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